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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,119	06/14/2001	Andrew D. Ellington	119927-1050	8203

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EXAMINER

EPFS FORD, JANET L

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/883,119

Applicant(s)

ELLINGTON ET AL.

Examiner

Janet L. Epps-Ford, Ph.D.

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 15 October 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-6, 9-14, 128 and 137 remain rejected for the reasons of record.

Claim(s) withdrawn from consideration: \_\_\_\_\_

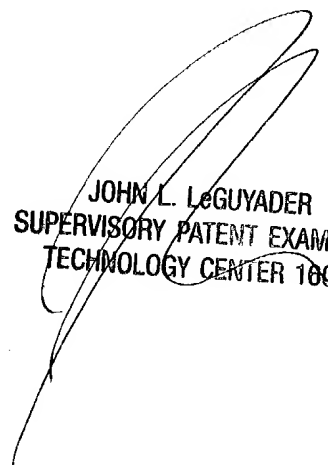
8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Janet L. Epps-Ford, Ph.D.  
Patent Examiner  
Art Unit: 1635

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's reply does not overcome the rejection of claims 1-6, 9-14, 128 and 137 under 35 USC 112, 1st paragraph for lack of written description. Applicant's arguments have been fully considered but they are not persuasive. Applicants traverse the instant rejection on the grounds that because Applicants have provided 3 examples of regulatable catalytically active molecules, specifically the Reve dependent RNA ligase ribozyme, Cyt18 dependent ribozyme ligase, and the hen egg white lysozyme dependent ribozyme ligase, they have fully described the claimed invention. Contrary to Applicant's assertions, it is noted that the instant claims are drawn to DNA polynucleotides that are regulated by a peptide effector and are catalytically active. Applicants have not provided the structure of a single DNA polynucleotide that is regulated by a peptide effector and is catalytically active. The recitation of only functional language in the instant claims, and the prophetic teaching in the specification as filed is not sufficient to describe the structure of the claimed DNA polynucleotides, since there is no known or disclosed correlation between the functional language in the claims and the corresponding structure of the claimed DNA polynucleotides.

Additionally, Applicant's arguments do not overcome the rejection of claims 1-2, 5, 9-10, 12-13 and 137 under 35 USC 102(b). According to Applicants since the George et al. reference is prophetic in nature, it cannot anticipate the instant claims. Contrary to Applicant's assertions, although the disclosure of George et al. maybe prophetic, a disclosure that is prophetic in nature does not necessarily preclude the skilled artisan from practicing an invention. George et al. specifically states at col. 2, lines 54-56, that the invention described therein for RNA catalytic motifs is applicable as well to DNA catalytic motifs. Thus, absent evidence to the contrary, "one skilled in the art would be able to practice such an invention," since one would merely have to use a DNA catalytic motif in place of an RNA catalytic motif following the teachings of the specification of George et al.

The mere fact that the specification of George et al. is prophetic with regard to catalytic DNAs has no bearing, per se, with the ability of the skilled artisan to practice the invention disclosed by George et al. Applicants do not offer any rationale, scientific and/or legal, in support of their assertions. Applicants simply conclude that one of skill in the art would not be able to practice the invention of George et al. without offering any objective evidence that prophetic teachings, in the instant situation, are not applicable. It is interesting to note that Applicant's own specification is prophetic with regard to catalytic DNA motifs. The fact that applicants question prophetic teachings would appear to lend support to the instant written description rejection.



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